

DOCKET NO.: PHD 99.027
CLIENT NO.: PHIL06-99027

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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : NORBERT KUNZE, ET AL.
Serial No. : 09/674,669
Filed : November 2, 2000
For : CHANGING GEAR IN A DISC PLAYBACK UNIT WITH TWO
ALTERNATE DRIVE OUTPUTS (AS AMENDED)
Group No. : 2652
Examiner : D. C. Nguyen

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Sir:

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

The undersigned hereby certifies that the following documents:

1. Postcard Receipt;
2. Petition to Withdraw Holding of Abandonment;
3. Statement of Linda Cuccia (w/Account Detail Report); and,
4. Copy of Amendment Under 37 C.F.R. §1.111, Certificate of Mailing by First Class Mail, and postcard receipts as mailed to the U.S. Patent and Trademark Office on July 23, 2003

relating to the above application, were deposited as "First Class Mail" with the United States Postal Service, addressed to Office of Patent Publications, 2231 Crystal Drive, Crystal Park 3, Suite 920, Arlington, VA 22202, on December 19, 2003.

Date: Dec 19, 2003

Kathy Hamilton
Mailer

Date: 19 Dec. 2003

John T. Mockler
John T. Mockler, Reg. No. 39,775

P.O. Drawer 800889
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Sir:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

In response to the Notice of Abandonment mailed November 28, 2003, Applicant submits this Petition.

An Amendment Under 37 C.F.R. §1.111 in response to the April 23, 2003 Office Action, was mailed to the United States Patent and Trademark on July 23, 2003. The Certificate of Mailing was signed by Linda Cuccia and the undersigned attorney of record, John T. Mockler. A copy of the documents as filed are attached hereto.

Also attached hereto is an executed Statement of Linda Cuccia explaining the steps taken to timely file the Amendment in the above-identified matter.

Finally attached hereto is a Detail Report indicating that postage was charged to matter

number PHIL06-99027 on July 23, 2003 in the amount of \$1.98 (\$0.23 for pre-paid postage on postcard receipt, and \$1.75 for the mailing of the Amendment).

The Detail Report also references copies charged to the same matter.

Applicant respectfully requests that the holding of abandonment be withdrawn and the application be allowed to pass to issuance.

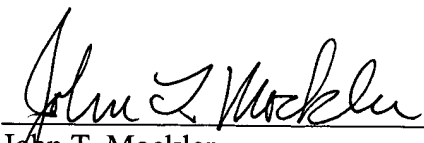
While no fee is believed to be due for the filing of this Petition, the Commissioner is authorized to charge any additional fees or credit any overpayment of fees due by virtue of this Petition to DAVIS MUNCK Deposit Account No. 50-0208.

If the Examiner requires any further assistance in this matter, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@davismunck.com*.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 19 Dec. 2003



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PATENT

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In re application of : NORBERT KUNZE, ET AL.

Serial No. : 09/674,669

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Sir:

STATEMENT OF LINDA CUCCIA

I, Linda Cuccia, hereby attest on a personal knowledge basis to the timely mailing of Applicant's Amendment Under 37 C.F.R. §1.111, Certificate of Mailing, and two return postcard receipts, and make the following Statement in support of the Petition to Withdraw Holding of Abandonment:

In response to the final Office Action dated April 23, 2003, I prepared the Amendment Under 37 C.F.R. §1.111 and Certificate of Mailing for execution by the attorney of record, John T. Mockler, for submission to the United States Patent and Trademark Office. Copies of the executed paperwork are attached to the Petition to Withdraw Holding of Abandonment filed concurrently herewith.

Also attached hereto is a User Detail Report indicating that copies were made and charged to PHIL06-99027 on July 23, 2003. The User Detail Report also indicates that postage was charged to PHIL06-99027 on July 23, 2003 in the amount of \$1.75 (\$0.23 postcard fee and \$1.75 for postage).


On July 23, 2003, I executed the Certificate of Mailing and hand-delivered the envelope to the United States Post Office located in Dallas, Texas.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date

Dec. 19, 2003



Linda Cuccia
Legal Secretary to John T. Mockler

DAVIS MUNCK, A PROFESSIONAL CORPORATION

ACCOUNT DETAIL REPORT

Date Range
 From 7/23/2003 0:00
 To 7/23/2003 23:59

Phil06-99027 Philips Electronics North Amer / U.s. Patent Application

Copy Transaction(s)

User Name	Date	Time	Unit ID	Description	Size	Pages	Net Charges	Status
Hamilton Frederick	7/23/2003	09:33	CFX02	Letter	Letter	12	2.40	Billed
Cuccia Linda	7/23/2003	17:29	CFX02	Letter	Letter	51	10.20	Billed
Trans totals for Copy:						63	12.60	

Disb Transaction(s)

User Name	Date	Time	Unit ID	Description	DisbName	Net Charges	Status
Cuccia Linda	7/23/2003	16:53	POSTRAK1	Postage	Postage	0.23	Billed
Cuccia Linda	7/23/2003	16:53	POSTRAK1	Postage	Postage	1.75	Billed
Trans totals for Disb:						1.98	

Totals For Phil06-99027:

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Mailed: July 23, 2003
 In re. Application of: Norbert Kunze, et al
 Serial No.: 09/674,669
 Filed: November 2, 2000
 Title: CHANGING GEAR IN A DISC PLAYBACK UNIT WITH TWO ALTERNATE DRIVE OUTPUTS (AS AMENDED)
 Docket No.: PHD 99,027 (PHIL06-99027)

The following documents were received in the U.S. Patent and Trademark Office on the date stamped below:

- 1) Certificate of Mailing by First Class Mail;
- 2) Amendment Under 37 C.F.R. § 1.111

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DOCKET NO. PHD 99027 DIV. SER. NO. 09/674669
Changing Gear in a Disc Playback Unit With
Two Alternate Drive Outputs (as Amended)

PLEASE DATE STAMP AND RETURN TO
 ACKNOWLEDGE RECEIPT OF NOTED DOCUMENTS

Application	<input type="checkbox"/>	Amendment	<input checked="" type="checkbox"/>
<u> </u> Pages of		Issue Fee	<input type="checkbox"/>
spec., claims & abs.		Notice of Appeal	<input type="checkbox"/>
Con. Doc.	<input type="checkbox"/>	Extension	<input type="checkbox"/>
Drawings	Inf. <input type="checkbox"/>	Mailing Cert.	<input checked="" type="checkbox"/>
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Group No. : 2652
Examiner : D. C. Nguyen

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MAIL STOP NON-FEE-AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

The undersigned hereby certifies that the following documents:

1. Amendment Under 37 C.F.R. § 1.111; and
2. Two (2) postcard receipts;

relating to the above application, were deposited as "First Class Mail" with the United States Postal Service, addressed to MAIL STOP NON-FEE AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 23, 2003.

Date: July 23, 2003

Date: 23 July 2003

Mailed

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MAIL STOP NON-FEE-AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

AMENDMENT UNDER 37 C.F.R. § 1.111

This Amendment Under 37 C.F.R. § 1.111 responds to an Office Action mailed on April 23, 2003, in the above referenced patent application. The Office Action has a shortened statutory period of response set to expire on July 23, 2003. Please amend the patent application as indicated below.

IN THE SPECIFICATION:

Please amend Page 3, Lines 17-25 as follows:

The operation of a changing gear according to the invention will be explained below. Fig. 1 shows the changing gear with a first output member 2, a second output member 1, a changing wheel 3, an adjustment member 4, and a control element 7 14 in position in which the first output is driven. The changing wheel 3 is rotatably journaled on a pivot lever 5 and is engagement with the rack 2 of the ~~second~~ first output side. The pivot lever 5 can be pivoted by means of its catch pin 5a and the contour 4a of the adjustment member 4 when the adjustment member 4 is displaced against the direction of arrow A, so that the changing wheel 3 can be brought into engagement with the drive wheel 1 of the second output side. This situation is visible in Fig. 2.

IN THE CLAIMS:

Please amend the pending claims as follows:

1. (Currently amended) A device for playing and storing several disc-shaped data carriers with changing facility, in particular CDs, CD-ROMs, and DVDs, with a playback unit designed for playing the a data carrier and ~~consisting substantially of a base plate, a frame plate, and springs and dampers arranged therebetween, a turntable arranged on the frame plate and supporting the data carrier, and a tensioning device for the data carrier, with a stacking unit serving for the intermediate storage of several data carriers and a loading unit serving for the bidirectional transport of the data carrier between the stacking unit and the playback unit as well as for moving the data carrier into and out of the device,~~ wherein said device comprises a changing gear is provided which has two alternate drive outputs, the first drive output (2) being designed inter alia for the function of adjusting a control member (14) ~~which can be moved~~ is movable further from an extreme position of the first drive output (2) by means of a further drive, with the result that an adjustment member (4) carries out ~~the a~~ a switching-over operation between the two alternate drive outputs.

2. (Currently amended) A device as claimed in claim 1, wherein a changing wheel (3) which is rotatably journaled about a drive wheel (9) on a pivoting lever (5) ~~can be adjusted~~ is adjustable by means of an adjustment member (4) which is kept in or brought into a first end position by a spring (6), as a result of which ~~the~~ a first output side (2) of the changing gear is in engagement.

3. (Currently amended) A device as claimed in ~~claim 1~~ claim 2, wherein the spring (6) is constructed as a leg spring whose second leg (6b) is supported against a frame (10), whose turn or turns is/are supported on a mandrel (8) of the adjustment member (4), and whose first leg (6a) in said first end position is also supported against the adjustment member (4), such that ~~the~~ a spring force acts with displacement effect on the adjustment member (4) from the second leg (6b) only, while the adjustment member (4) for the purpose of coupling the second outside side of the changing gear by means of a control element (14), which acts on the first leg (6a) of the spring (6) and compensates ~~the~~ a contact force thereof on the adjustment member (4), changes the balance of forces such that ~~the~~ a spring force between the control ~~element~~ member (14) and the adjustment member (4) becomes greater than ~~the~~ a spring force on the second leg (6b) and the frame (10), with the result that the adjustment member (4) moves toward the second end position until the second end position is reached, whereby the movement of the adjustment member (4) is blocked, whereas the first leg (6a) of the spring (6) is displaced further by the control element (14) and is thus lifted off the adjustment member (4) at point B.

4. (Currently amended) A device as claimed in claim 1, wherein ~~the~~ a coupling region between the first output member (2) and the control member (14) is constructed such that the first output member (2) and the control member (14) ~~can move~~ are movable relative to one another in the direction of movement of the control member (14), and ~~the~~ a resulting clearance space is utilized for coupling and uncoupling ~~the~~ a first drive output side (2).

5. (Currently amended) A changing gear, in particular for a device for playing and storing several disc-shaped data carriers, wherein said changing gear has two alternate drive outputs, the first drive output (2) being designed inter alia for the function of adjusting a control member (14) which ~~can be moved~~ is movable further from an extreme position of the first drive output (2) by means of a further drive, with the result that an adjustment member (4) carries out ~~the~~ a switching-over operation between the two alternate drive outputs.

6. (Currently added) A device claimed in claim 2, wherein a coupling region between the first output member (2) and the control member (14) is constructed such that the first output member (2) and the control member (14) are movable relative to one another in the direction of movement of the control member (14), and a resulting clearance space is utilized for coupling and uncoupling a first drive output side (2).

7. (Currently added) A device claimed in claim 3, wherein a coupling region between the first output member (2) and the control member (14) is constructed such that the first output member (2) and the control member (14) are movable relative to one another in the direction of movement of the control member (14), and a resulting clearance space is utilized for coupling and uncoupling a first drive output side (2).

8. (Currently added) A changing gear as claimed in claim 5, further comprising a changing wheel (3) which is rotatably journaled on a pivoting lever (5) that is adjustable by means of an adjustment member (4) which is kept in or brought into a first end position by a spring (6), as a result of which a first output side (2) of the changing gear is in engagement.

9. (Currently added) A changing gear as claimed in claim 8, wherein the spring (6) is constructed as a leg spring whose second leg (6b) is supported against a frame (10), whose turn or turns is/are supported on a mandrel (8) of the adjustment member (4), and whose first leg (6a) in said first end position is also supported against the adjustment member (4), such that a spring force acts with displacement effect on the adjustment member (4) from the second leg (6b) only, while the adjustment member (4) for the purpose of coupling the second outside side of the changing gear by means of a control element (14), which acts on the first leg (6a) of the spring (6) and compensates a contact force thereof on the adjustment member (4), changes the balance of forces such that a spring force between the control member (14) and the adjustment member (4) becomes greater than a

spring force on the second leg (6b) and the frame (10), with the result that the adjustment member (4) moves toward the second end position until the second end position is reached, whereby the movement of the adjustment member (4) is blocked, whereas the first leg (6a) of the spring (6) is displaced further by the control element (14) and is thus lifted off the adjustment member (4) at point B.

10. (Currently added) A changing gear as claimed in claim 5, wherein a coupling region between the first output member (2) and the control member (14) is constructed such that the first output member (2) and the control member (14) are movable relative to one another in the direction of movement of the control member (14), and a resulting clearance space is utilized for coupling and uncoupling a first drive output side (2).

11. (Currently added) A changing gear as claimed in claim 8, wherein a coupling region between the first output member (2) and the control member (14) is constructed such that the first output member (2) and the control member (14) are movable relative to one another in the direction of movement of the control member (14), and a resulting clearance space is utilized for coupling and uncoupling a first drive output side (2).

12. (Currently added) A changing gear as claimed in claim 9, wherein a coupling region between the first output member (2) and the control member (14) is constructed such that the first output member (2) and the control member (14) are movable relative to one another in the direction of movement of the control member (14), and a resulting clearance space is utilized for coupling and uncoupling a first drive output side (2).

13. (Currently added) A method for operating a device for playing and storing several disc-shaped data carriers with changing facility, in particular CDs, CD-ROMs, and DVDs, with a playback unit designed for playing a data carrier, wherein the method comprises the steps of:

providing a changing gear in said device wherein said changing gear has two alternate drive outputs;

adjusting a control member (14) of the changing gear with the first drive output (2);

moving the control member (14) further from an extreme position of the first drive output (2) by means of a further drive; and

causing the adjustment member (4) to carry out a switching-over operation between the two alternate drive outputs.

14. (Currently added) A method as claimed in claim 13, further comprising the steps of:
providing a changing wheel (3) in said changing gear wherein said changing wheel (3) is
rotatably journaled on a pivoting level (5);

adjusting said changing wheel (3) with an adjustment member (4) of said changing gear
which is kept in or brought into a first end position by a spring (6); and

engaging the first output side (2) of said changing gear with said adjustment member (4).

15. (Currently added) A method as claimed in claim 13, further comprising the steps of:
constructing the spring (6) as a leg spring whose second leg (6b) is supported against a frame
(10), whose turn or turns is/are supported on a mandrel (8) of the adjustment member (4), and whose
first leg (6a) in said first end position is also supported against the adjustment member (4), such that
a spring force acts with displacement effect on the adjustment member (4) from the second leg (6b)
only, while the adjustment member (4) for the purpose of coupling the second outside side of the
changing gear by means of a control element (14), which acts on the first leg (6a) of the spring (6)
and compensates a contact force thereof on the adjustment member (4), changes the balance of forces
such that a spring force between the control member (14) and the adjustment member (4) becomes
greater than a spring force on the second leg (6b) and the frame (10);

moving the adjustment member (4) toward the second end position until the second end
position is reached, whereby the movement of the adjustment member (4) is blocked; and

further displacing the first leg (6a) of the spring (6) by the control element (14) and lifting off the adjustment member (4) at point B.

16. (Currently added) A method as claimed in claim 13, further comprising the steps of:
constructing a coupling region between the first output member (2) and the control member (14) such that the first output member (2) and the control member (14) are movable relative to one another in the direction of movement of the control member (14); and
utilizing a resulting clearance space for coupling and uncoupling a first drive output side (2).

17. (Currently added) A method as claimed in claim 14, further comprising the steps of:
constructing a coupling region between the first output member (2) and the control member (14) such that the first output member (2) and the control member (14) are movable relative to one another in the direction of movement of the control member (14); and
utilizing a resulting clearance space for coupling and uncoupling a first drive output side (2).

18. (Currently added) A method as claimed in claim 15, further comprising the steps of:
constructing a coupling region between the first output member (2) and the control member (14) such that the first output member (2) and the control member (14) are movable relative to one another in the direction of movement of the control member (14); and
utilizing a resulting clearance space for coupling and uncoupling a first drive output side (2).

19. (Currently added) A method as claimed in claim 15 further comprising the step of:
causing the adjustment member (4) to carry out a switching-over operation between the two
alternate drive outputs automatically without manual operation.

20. (Currently added) A method as claimed in claim 19 further comprising the step of:
causing the automatic switch-over to occur when a spring force between the control element and the
adjustment member becomes greater than a spring force of a second spring leg exerted on the frame
of the changing gear.

REMARKS

Claims 1-5 are pending in the present patent application (the "Application").

Claims 1-5 have been rejected

Claims 1-5 have been amended.

Claims 6-20 have been added.

Claims 1-20 remain in the Application.

Reconsideration and allowance of the pending claims is respectfully requested.

Title

On Page 2 of the April 23, 2003 Office Action, the Examiner objected to the title as not being descriptive of the invention. The Applicants have amended the title to read "Changing Gear in a Disc Playback Unit With Two Alternate Drive Outputs." The Applicants respectfully submit this new title for approval of the Examiner.

Claim Objections

On Page 2 of the April 23, 2003 Office Action, the Examiner suggested that the phrase "a control element" in Claim 3 should read "a control member" for consistency. The Applicants have amended Claim 3 to make the requested change.

Drawings

On Page 2 of the April 23, 2003 Office Action, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a). The Applicants have amended the claims to remove elements that are not shown in the drawings. The Applicants respectfully submit that the amendment to the claims removes the basis for the Examiner's objections.

Claim Rejections – 35 U.S.C. § 112

On Page 3 of the April 23, 2003 Office Action, the Examiner objected to Claims 1-5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Applicants have amended Claims 1-5 to provide an antecedent basis for each of the claim elements. The Applicants respectfully submit that the amendment to the claims removes the basis for the Examiner's objection.

Claim Rejections – 35 U.S.C. § 102 (Anticipation)

On Page 4 of the April 23, 2003 Office Action, the Examiner rejected Claim 5 under 35 U.S.C. § 102 as being anticipated by United States Patent No. 5,313,351 to *Lee*. On Page 5 of the April 23, 2003 Office Action, the Examiner rejected Claim 5 under 35 U.S.C. § 102 as being anticipated by United States Patent No. 6,151,279 to *Ikedo et al.* (hereafter "*Ikedo*"). The Applicants respectfully traverse these rejections.

It is axiomatic that a prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131. See, *In re King*, 231 USPQ 126, 138 (Fed. Cir. 1986) (citing with approval, *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984)); *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131. *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985).

With respect to Claim 5, a determination of anticipation in accordance with 35 U.S.C. § 102 requires that each feature claimed therein be described in sufficient detail in *Lee* or in *Ikedo* to enable one of ordinary skill in the art to make and practice the claimed invention.

With respect to the *Lee* reference the Examiner stated "Regarding claim 5, Lee teaches a changing gear [fig. 1], in particular for a device for playing and storing several disc shaped data carriers [col.2 lines 29], wherein said changing gear has two alternate drive outputs [8 and 21], the first drive output [8] being designed inter alia for the function of adjusting a control member [16] which can be moved further from an extreme position of the first drive output [8] by means of a further drive [e.g. 21] the result that an adjustment member [16-19] carries out a switching-over operation [open/shut the door] (col.2 lines 53-58)." (April 23, 2003 Office Action, Page 4).

The Applicants respectfully traverse the Examiner's characterization of the subject matter of the *Lee* reference.

The element that the Examiner identified as the first drive output [moving rack 8] does not adjust a control member [identified by the Examiner as connecting gear 16]. Connecting gear 16 of *Lee* is one gear of a plurality of connecting gears in a gear train. Connecting gear 16 is located between connecting gear 15a and connecting gear 19a. Connecting gear 16 is not a control member. Connecting gear 16 is simply a conduit of rotational motion in a gear train of connecting gears. There is no control feature present in connecting gear 16. Further, connecting gear 16 is not "moved further from an extreme position of the first drive input [8] by means of a further drive [e.g. 21]." Opening and shutting rack 21 does not provide drive means for moving a control member. Opening and shutting rack 21 does not move connecting gear 16 "further from an extreme position of the first drive input [8]." *Lee* does not disclose an adjustment member for carrying out a switching over operation between two alternate drive inputs. The Examiner identified the connecting gears 16-19 as "an adjustment member" of the type claimed by the Applicants in Claim 5. The connecting gears 16-19 are not controlled by "a control member" of the type claimed by the Applicants in Claim 5 and are not "an adjustment member" of the type claimed by the Applicants in Claim 5.

For the reasons set forth above, the Applicants respectfully submit that the rejection of Claim 5 as being anticipated by the *Lee* reference has been overcome. The Applicants respectfully request that Claim 5 be passed to allowance.

With respect to the *Ikedo* reference the Examiner stated "Regarding claim 5, Ikedo et al teach a changing gear [fig 3], in particular for a device for playing and storing several disc shaped data carriers [311-312], wherein said changing gear has two alternate drive outputs [210] and, the first drive output [8] being designed inter alia for the function of adjusting a control member [16] which can be moved further from an extreme position of the first drive output [8] by means of a further drive [e.g. 21] the result that an adjustment member [16-19] carries out a switching-over operation [open/shut the door] (see fig 3)." (April 23, 2003 Office Action, Page 5). The Applicants respectfully traverse the Examiner's characterization of the subject matter of the *Ikedo* reference.

The element that the Examiner identified as the first drive output [8] does not adjust a control member [16]. The Applicants have found no elements in the *Ikedo* reference that are numbered 8 or 16. The Applicants have found no control member in *Ikedo* that is identical to the control member 14 of the Applicants' invention. The Examiner identified elements [16-19] as an adjustment member. The Applicants have found no elements in the *Ikedo* reference that are numbered 16-19. The Applicants have found no adjustment member in *Ikedo* that is identical to the adjustment member 4 of the Applicants' invention.

For the reasons set forth above, the Applicants respectfully submit that the rejection of Claim 5 as being anticipated by the *Ikedo* reference has been overcome. The Applicants respectfully request that Claim 5 be passed to allowance.

Claim Rejections – 35 U.S.C. § 103 (Obviousness)

On Pages 5-8 of the April 23, 2003 Office Action, the Examiner rejected Claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,052,356 to *Fujimoto et al.* (hereafter "*Fujimoto*") in view of United States Patent No. 5,313,351 to *Lee*. The Applicants respectfully traverse these rejections.

During *ex parte* examinations of patent applications, the Patent and Trademark Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP § 2142.

For the reasons set forth below the Applicants respectfully submit that the Patent and Trademark Office has not established a *prima facie* case of obviousness with respect to Claims 1-4 of the Applicants' invention.

The Applicants respectfully submit that the Applicants' invention contains unique and novel claim limitations. For example, consider Claim 1.

1. (Currently amended) A device for playing and storing several disc-shaped data carriers with changing facility, in particular CDs, CD-ROMs, and DVDs, with a playback unit designed for playing a data carrier wherein said device comprises a changing gear which has two alternate drive outputs, the first drive output (2) being designed inter alia for the function of adjusting a control member (14) which is movable further from an extreme position of the first drive output (2) by means of a further drive, with the result that an adjustment member (4) carries out a switching-over operation between the two alternate drive outputs. (Emphasis added).

On Page 6 of the April 23, 2003 Office Action the Examiner stated "Regarding Claim 1, Fujimoto et al teach a device [fig 1] for playing and storing several disc-shaped data carriers [14] with changing facility, in particular CDS, CD-ROMs, and DVDs, with a playback [15] unit designed for playing the data carrier [disks] * * * Fujimoto et al do not teach a changing gear is provided which has two alternate drive outputs, the first drive output being designed inter alia for the function of adjusting a control member which can be moved further from an extreme position of the first drive output by means of a further drive, with a result that an adjustment member carries out a switching-over operation." (April 24, 2003 Office Action, Page 6).

The Applicants agree that the *Fujimoto* reference discloses a device for playing and storing several disc-shaped data carriers with changing facility, in particular CDS, CD-ROMs, and DVDs, with a playback unit designed for playing the data carrier disks.

The Applicants agree that the *Fujimoto* reference does not disclose "a changing gear is provided which has two alternate drive outputs, the first drive output being designed inter alia for the function of adjusting a control member which can be moved further from an extreme position of the first drive output by means of a further drive, with a result that an adjustment member carries out a switching-over operation."

The Examiner has asserted that it would have been obvious to combine the *Lee* reference with the *Fujimoto* reference to overcome the deficiencies of the *Fujimoto* reference. (April 23, 2003 Office Action, Pages 6-7). The Applicants respectfully traverse this assertion of the Examiner.

The Applicants hereby reiterate and incorporate by reference all of the comments that the Applicants have previously made concerning the subject matter of the *Lee* reference. For the reasons that have been previously given, the *Lee* reference does not disclose the unique and novel claim limitations of the Applicants' invention.

The supposed advantage of combining the teachings of the *Lee* reference with the teachings of the *Fujimoto* reference is that would provide "the loading mechanism for loading disks in and out and driving the pick up by a single motor." (April 24, 2003 Office Action, Page 7, Lines 9-10). The Applicants point out that this supposed motivation to combine the references is very general and does not specifically suggest combining the teachings of the *Lee* reference with the teachings of the *Fujimoto* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The supposed motivation is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings. There is no suggestion or motivation in either *Lee* or *Fujimoto* to combine the two references. The alleged motivation to combine the *Lee* reference and the *Fujimoto* reference originates by considering the Applicants' invention in hindsight.

Even if the *Lee* reference could be combined with the *Fujimoto* reference, the combination would not teach, suggest, or even hint at the Applicants' invention as set forth in Claims 1-4. MPEP § 2142 indicates that a prior art reference (or references when two or more references are

combined) must teach or suggest all the claim limitation of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. In the present case, (1) the combination of the *Lee* reference and the *Fujimoto* reference would not teach or suggest all of the unique and novel claim limitations of the Applicants' invention, and (2) the reasonable expectation of success is found in the Applicants' disclosure.

The Applicants respectfully submit that the limitations of independent Claim 1 are not disclosed, suggested or hinted at in the *Lee* reference, or in the *Fujimoto* reference, or in a combination of the two references. Therefore, independent Claim 1 is patentable over the *Lee* reference, and over the *Fujimoto* reference, and over a combination of the two references. The Applicants note that Claims 2-4 depend from Claim 1 and contain all of the unique and novel limitations recited in Claim 1. Therefore, Claims 2-4 are patentable over the *Lee* reference, and over the *Fujimoto* reference, and over a combination of the two references.

The Applicants therefore respectfully requests that the rejection of Claims 1-4 under 35 U.S.C. § 103(a) be withdrawn. The Applicants respectfully request that Claims 1-4 be passed to allowance.

The Applicants further note that newly added Claims 6-20 contain unique and novel limitations that are analogous to the unique and novel limitations recited in independent Claim 1.

For this reason newly added Claims 6-20 are also patentable over the *Lee* reference, and over the *Fujimoto* reference, and over a combination of the two references.

The Applicants therefore respectfully request that Claims 1-20 be passed to allowance.

The Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicants reserve the right to submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

SUMMARY

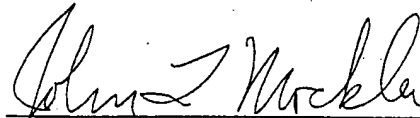
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at jmockler@davismunck.com. No fees are believed to be necessary; however, in the event that any fees are required for the prosecution of this application, please charge any necessary fees or credit any refunds to Deposit Account No. 50-0208. No extension of time is believed to be necessary. If, however, an extension of time is needed, the extension is requested and please charge the fee for the extension to Deposit Account No. 50-0208.

Respectfully submitted,

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